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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,598

01/20/2004

Peter M. Bonutti

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1100

30074 7590 01/22/2010  
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EXAMINER

BROWN, MICHAEL A

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

01/22/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,598	<b>Applicant(s)</b> BONUTTI ET AL.	
	<b>Examiner</b> MICHAEL BROWN	<b>Art Unit</b> 3772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,10,11,23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 12-14 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-9 and 12-14 and 15-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor '643.

Taylor discloses in figures 1-4 a shoulder orthosis device for effecting rotational movement of a lower arm portion of a patient's arm about a central longitudinal axis of a humerus bone of an upper arm portion of the patient's arm comprising a lower arm section 40, configured for receiving the lower arm portion, the lower arm section configured, dimensioned and arranged for maintaining the lower arm portion substantially orthogonal to the upper arm portion, a drive member 20, connected to the lower arm section proximate the elbow and including a gear (a worm gear), connected to the lower arm section having an axis substantially coincidental with the central longitudinal axis of the humerus and manually operable by the patient to rotate the lower arm portion about the central longitudinal axis of the humerus bone, during at least a portion of rotation of the gear the humerus is rotated through its connection with the lower arm portion of the patient's arm about its longitudinal axis and body tissue in the shoulder can be stretched, the lower arm section includes a lower cuff 32 and a hand cuff (at 31), the drive unit rotates the lower arm section (via the motor and the

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worm gear), the drive section rotates the lower arm section from a second position to a third position, an upper arm section 28, rotatably connected to the lower arm section, the upper section is adjustable to align the upper arm portion (with a glenoid cavity of a shoulder joint), a base 32, that is pivotally (at 29) connected to the upper arm section, means 24, associated with the manually operated drive member operative to maintain a position of the gear, the length of the upper arm section is adjustable (movable from one location to another location), the length of the lower section is adjustable (moveable from one location to another location) and a secondary drive member 30. The lower arm section holding the hand of the patient with the palmar surface of the hand of the patient coplanar with the drive member axis is a function of the present invention that provide no novelty or an inventive step over the prior art. The hand with a palmar surface is connected to the lower arm portion of a patient. Holding the palmar surface of the hand coplanar with the drive member axis is a function of the present invention

***Allowable Subject Matter***

Claims 4-5, 10-11 and 23-24 are allowed.

***Response to Arguments***

Applicant's arguments filed January 2, 2009 have been fully considered but they are not persuasive. Applicant argues that Taylor '643 discloses a continuous passive motion device where the planar surface of the user's hand is orthogonal (i.e., not coplanar) with the drive member axis. However, since no portion of the body can be claimed, patentable weight is without merit when considering where the user's hand is located while wearing a shoulder orthosis. If patentable weight was given to where the

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hand is located then all one would have to do is change the location of the hand and the same invention would be patentable over the same invention. Applicant argues that the orientation of hand according to the invention isn't obvious in light of Taylor because orienting the palmar surface parallel to the drive member axis allows the patient to be stretched in the direction where a patient's strength and motion are at a maximum. However, as set forth above where the hand is located doesn't provide any novelty or an inventive step over the prior art of record.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BROWN** whose telephone number is (571)272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Brown/  
Primary Examiner, Art Unit 3772